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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,132	02/12/2002	Scott Frederick Ansell	VTN-0577	8163

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EXAMINER
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HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/074,132

**Applicant(s)**

ANSELL ET AL.

**Examiner**

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-59 and 61-63 is/are rejected.
- 7) ☒ Claim(s) 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 June 2004 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

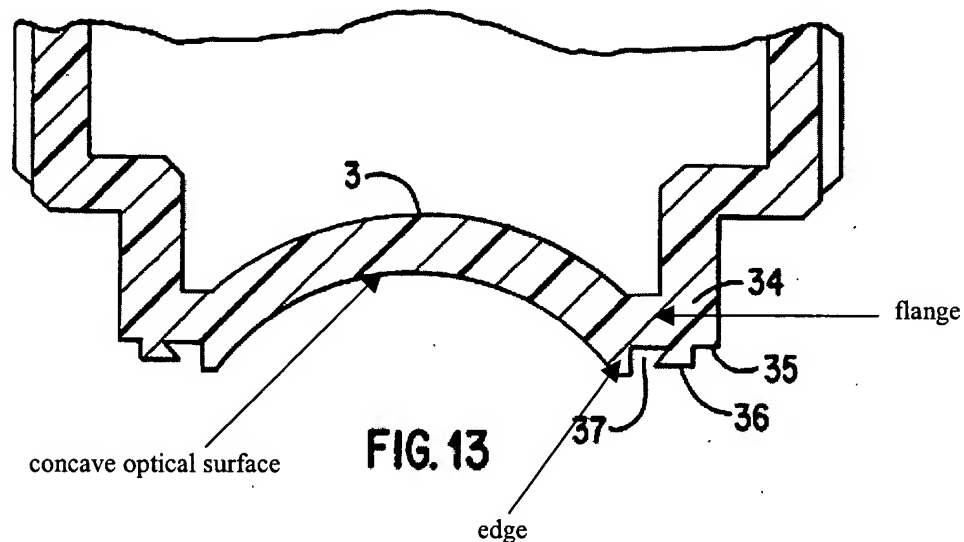
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 51 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Su et al. (U.S. Pat. No. 5,574,554; previously of record).

Su discloses a contact lens production system including a lens molding apparatus. As shown below in reproduction of the

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embodiment depicted in Fig. 13, the mold comprises a first mold portion comprising a concave optical surface, and edge, a first flange extending from the edge, and a depression (37) formed in the first flange.



As shown, for example in Fig. 4 of the reference, Su further discloses a second mold portion (4) comprising a convex surface and a second flange opposing the first flange of the first mold portion.

A reactive mixture overflow collector is created between the first flange and the second flange when the second mold portion contacts the first mold portion. The reactive mixture overflow collector is defined by a first closed side extending

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from the edge along the first flange and including a surface of the depression (37) and first closed side extending from the edge of the second flange and along a portion of the second flange opposing the protrusion (see Figs. 4 & 13, and cl. 9, 11. 10-15). As is evident from the edge portion of the first mold portion extending further downward than the excess material engaging ring (36) shown in Fig. 13, the reactive overflow collector portion will further include a open side situate between the first and second closed sides.

Claim 51 recites that "the second closed side has a surface area for contacting reactive overflow mixture that is greater than or equal to that of the first closed side." The amount of surface area of the sides contacting the overflow mixture is dependent on the amount of material used in the apparatus; that is, how much material overflows into the overflow collector. The amount of material used in the claimed molding apparatus, however, is not germane to the issue of patentability of the apparatus. If a prior art structure is capable of performing the claimed use, then it meets the apparatus claim limitation(s). In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In this case, as described above, Su discloses a mold in which overflow molding material is collected

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in the overflow collector surrounding the mold cavity as the first mold portion is set upon the second mold portion (4). As such, a minimal amount of overflow material would flow onto the second flange of the second mold portion, but not fully into the depression (37) of the first mold portion. In this case, the surface area of the second mold portion contacting the reactive mixture is greater than that of the first mold portion. Thus, the apparatus disclosed by Su is capable of operating in the manner recited in the use limitation of claim 51 with more overflow mixture being contained on the surface area of the second closed side, and as such anticipates this claim.

4. Claims 61 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepherd (U.S. Pat. No. 4,121,896; previously of record).

Shepherd discloses a molding apparatus for the production of contact lenses. The mold comprises a first mold portion (130) comprising a concave optical surface (140), a circumferentially extending edge, and a first flange (including the structure from the molding surface 140 to the base 132) extending radially outward from the edge (see Fig. 1). A second mold portion (110) is provided comprising a convex surface (120) and a radially extending second flange (including parts 114 and 112) that

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oppose the first flange. A protrusion (134) extends from the first flange and meets the second flange (see Fig. 7), such that overflow reactive mixture is inhibited from flowing beyond the protrusion (see for example, cl. 3, ll. 57-60).

5. Claims 61 is rejected under 35 U.S.C. 102(e) as being anticipated by Doke et al. (U.S. Pat. No. 6,071,111; previously of record).

Doke discloses a mold assembly for forming contact lenses. As shown in the embodiments depicted in Figs. 17 and 18 reproduced below, the assembly includes a first mold portion (2) comprising a concave optical surface, a circumferentially extending edge, and a first flange extending radially outward from the edge. The assembly also includes a second mold portion (4) comprising a convex surface and a radially extending second flange that opposes the first flange. A protrusion extends from the first flange and nearly meets the second flange, such that a overflow reactive mixture (82) is substantially inhibited from flowing beyond the protrusion.

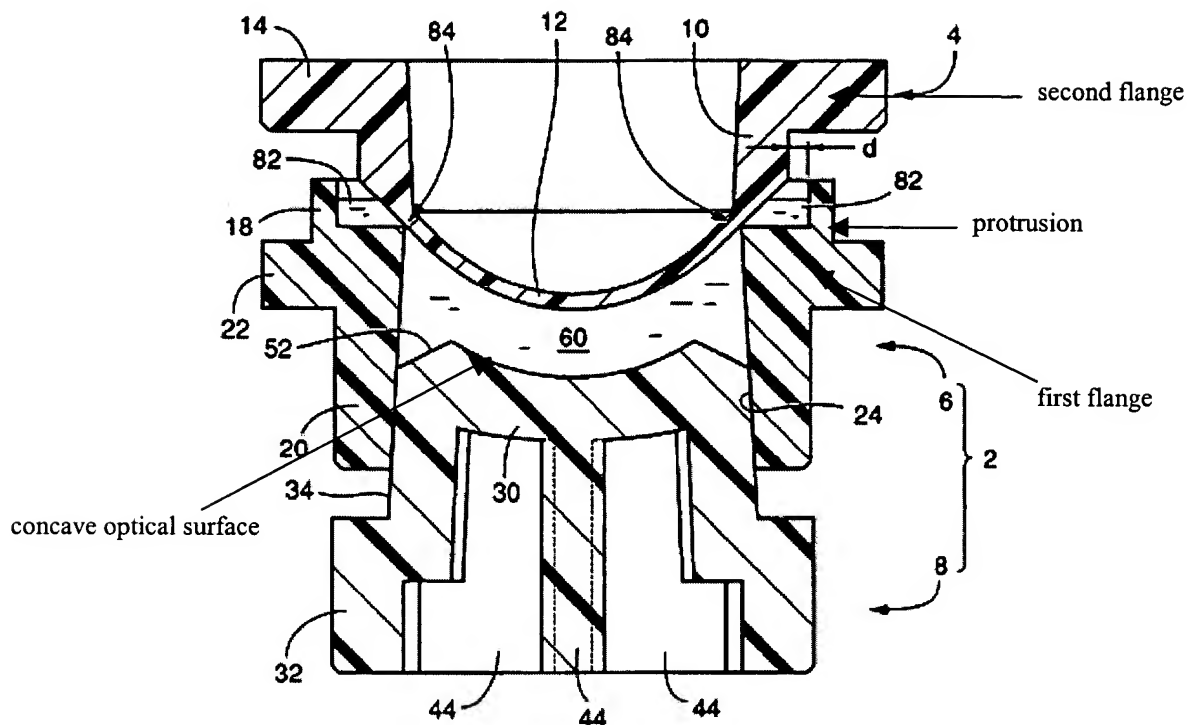


FIG. 17

6. Claim 63 is rejected under 35 U.S.C. 102(e) as being anticipated by Crowe, Jr. et al. (U.S. Pat. No. 5,975,875; previously of record).

Crowe discloses a molding device for forming contact lenses. A first mold portion (14) comprises a concave optical surface, a circumferentially extending edge, and a first flange extending from the edge. A second mold portion (16) comprises a convex surface and a second flange extending from the convex surface that opposes the first flange. In the embodiment shown in Figs. 7 and 8, a protrusion (72) extends from the second



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flange, and the protrusion is not present along the entire circumference of the second flange. Placed as such on the flange, the protrusion would act to inhibit overflow reaction mixture from freely spreading on the first and second flanges.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

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establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doke.

Doke discloses the mold assembly as described above. Doke does not disclose the exact location of the protrusion relative

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to the edge as recited in claims 56-58. Doke does, however, note that the spacing between the apparatus components, including the protrusion relative to other apparatus components, is a cause effective variable to be optimized within the apparatus (cl. 16, ll. 37-67). Normally, the determination of the optimum value of a cause effective variable is generally seen as within the skill of one practicing the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the instant case, as Doke discloses a molding apparatus with the same structural features and intended purpose of molding contact lenses, it would have been obvious to one of ordinary skill in the art to have modified the distance between the protrusion and the edge in the device of Doke because the reference suggests this is a cause effective variable to be optimized, and such an optimization is generally seen as within the skill of one practicing the art.

11. Claims 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su in view of Doke.

Su discloses the apparatus as described above. Su does not mention the particular spacing between the protrusion and the edge.

Doke also discloses the apparatus as described above. Doke notes, in particular, that the spacing between the apparatus components including the protrusion is a cause effective variable to be optimized with the apparatus (cl. 16, ll. 37-67). Normally, the determination of the optimum value of a cause effective variable is generally seen as within the skill of one practicing the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the instant case, as Su discloses a molding apparatus with the same structural features and intended purpose of molding contact lenses, it would have been obvious to one of ordinary skill in the art to have modified the distance between the protrusion and the edge in the device of Su because Doke suggests this is a cause effective variable to be optimized, and such an optimization is generally seen as within the skill of one practicing the art.

12. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Su in view of Martin et al. (U.S. Pat. No. 5,935,492).

Su discloses the apparatus as described above. Su does not disclose the first or second closed sides of the overflow collector to include a surfactant. Martin, however, discloses that it is known in the art to provide the surface onto which

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overflow mixture is collected with a surfactant in order to enable easier separation of the mold portions upon completion of molding (cl. 7, ll. 22-28). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device disclosed by Su as such to have provided a surfactant on the first or second closed sides of the overflow collector because this allows for easier separation of the mold portions upon completion of molding as suggested by Martin.

13. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doke as applied to claims 56-58 above, and further in view of Appleton et al. (U.S. Pat. No. 5,271,875).

Doke discloses the contact lens molding apparatus as described above. Doke does not disclose the protrusion to be tapered in a direction away from the first flange.

Appleton also discloses a mold for making contact lenses. Appleton's mold is provided with an overflow collector (59) which is formed in part by a protrusion (50) that is tapered in a direction away from the flange on which it was provided (see Fig. 9). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device of Doke as such to have a tapered protrusion

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because such a configuration is known to be suitable in overflow material collector as suggested by Appleton. Note, such a change amounts to merely a change in shape of the apparatus structure, normally, a change in the form or shape of a prior art structure is seen as an obvious modification to one of ordinary skill in the art unless it can be shown there is a new and unexpected result. In re Dailey, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966).

14. Claim 60 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for

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the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

  
Donald Heckenberg  
Primary Examiner  
A.U. 1722

11-21-5